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In re Application of	:	DECISION ON
KUMAR et al	:	
PCT No.: PCT/IB03/02186	:	
Application No.: 10/517,101	:	
Int. Filing Date: 09 June 2003	:	PETITION UNDER
Priority Date: 07 June 2002	:	
Attorney's Docket No.: RLL-266US	:	
For: MODIFIED RELEASE, MULTIPLE	:	
UNIT DRUG DELIVERY SYSTEMS	:	37 CFR 1.47(a)

This is in response to the "PETITION TO FILE WHEN AN INVENTOR CANNOT BE REACHED UNDER 37 C.R.F. § 1.47(a)" filed on 08 December 2005. The \$200.00 petition fee has been charged to petitioner Deposit Account No.: 50-0912 as stipulated in the petition.

BACKGROUND

On 09 June 2003, applicants filed international application PCT/IB03/02186, which claimed priority to an earlier application filed 07 June 2002. The thirty (30) month time period for paying the basic national fee in the United States of America expired at midnight on 07 December 2004.

On 07 December 2004, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter was, inter alia, the requisite basic national fee. No executed oath or declaration from the inventors accompanied the Transmittal Letter. A copy of the intentional application was transmitted on 18 December 2003 to the USPTO from the International Bureau.

On 09 May 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by International application number and international filing date." The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it: is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68. The notice also indicated that the items must be submitted within two months from the mailing date

of this notice or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 08 December 2005, petitioner filed the present petition accompanied, inter alia, an executed Declaration without the signature of one of the five inventors, i.e., without the signature of Ravikumar NITHIYANANDAM.

DISCUSSION

Petitioner's petition under 37 CFR 1.47(b) is improper because this petition is for the circumstance when all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort. In this situation two of the four inventors signed the declaration. Accordingly, the petition has been treated under 37 CFR 1.47(a).

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

REFUSAL TO JOIN:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the

application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See **MPEP § 106**. It is reasonable to require that the inventor be presented with the application papers before a petition under **37 CFR 1.47** is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the **37 CFR 1.47** applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has satisfied items (1), (3) and (4) of 37 CFR 1.47(a). However, item (2) has not been satisfied.

Regarding item 2, Mr. Hare states that Nithiyanandam has been presented with a copy of the application papers and has failed to respond to the request to sign the declaration. To date we have made numerous attempts to contact Mr. Nithiyanandam but have not received a response. However, it is unclear if the documents were actually mailed to him and received by the non-signing inventor or how the application papers were presented to Mr. Nithiyanandam because no documentary evidence to support this assertion has been provided such as a signed postal receipt and the cover letter addressed to Mr. Nithiyanandam instructing him what to do, or other evidentiary proof.

Moreover, the averments of Mr. Hare are insufficient to support a finding that the nonsigning inventor, Mr. Nithiyanandam, could not be reached after diligent effort because the petition fails to show diligent effort to locate him. The petition does indicated if Mr. Hare has searched for the above non-signing inventor new residential address either by the internet or by telephone directory, which would show diligent effort to find inventor Mr. Nithiyanandam.

In addition, it is unclear if Mr. Hare has first hand knowledge of the above facts with regard to the nonsigning inventor, if he doesn't then petitioner needs to submit statements, with specific facts on the actions referred above to the presentation of the application papers and the numerous attempts to contact the nonsigning inventor by persons who have first-hand knowledge of such facts.

The current record does not sufficiently establish Mr. NITHYANANDAM's refusal to join in the patent application because no evidentiary documents have been submitted to show that a *bona fide* attempt was made to deliver the complete application to him and that he refused to sign the required papers.

Consequently, the petition has not met the requirements under 37 CFR 1.47(a).

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time are available under 37 CFR 1.136(a). Failure to timely file the proper response will result in ABANDONMENT.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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